

REMARKS

Claims 1, 3-8, 10-17, 19-22, 26-53 and 55-60 are pending. Claims 2, 9, 18, 23-25, 54 and 61-67 are currently canceled. Claims 36 to 53 and 55 have been withdrawn from consideration. Claims 8, 20 and 21 are currently amended. Reconsideration of the application is requested.

Claim Objections

Claim 8 is objected to under 37 CFR 1.75c as being in improper dependant form. Claim 8 has been amended to make it dependent upon claim 6. Applicant submits that this amendment removes this objection.

§ 112 Rejections

Claims 1, 3-8, 10-17, 19-21, 28-35 and 56-60 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claim 1, the patent office views the recitation "an adhesive layer with a first major surface and a second major surface, wherein at least one of the first and second major surfaces is a structured surface" and the further recitation "the article has a non-structured exposed adhesive surface that can be adhered to a target substrate" are a broad range limitation and a narrow range limitation in the same claim and therefore is indefinite. Applicant respectfully submits that the limitations are not necessarily limited to a single layer. Even if the limitations are applied to a single layer, they are not indefinite. The claim states that there is an adhesive layer with first and second major surfaces and that at least one of these surfaces is structured. It goes on to state that the article has a non-structured adhesive surface that can be adhered to a target substrate. In the embodiment in which the adhesive layer with first and second major surfaces is the only adhesive layer in the article, the first surface is structured and the second surface is the non-structured adhesive surface that can be adhered to the target substrate. In other embodiments the article comprises additional adhesive layers.

In claim 21 the patent office views the recitation "the second major surface is structured surface" renders the claim vague and indefinite. Applicant has amended Claims 20 and 21 making them dependent upon Claim 6. In the embodiments of Claim 6, an additional adhesive

layer is claimed. Therefore, the simplest embodiment of Claim 21 provides for: a backing (which can be called backing 1, the backing described in claim 1); an adhesive layer with a first structured major surface directly adjacent to backing 1 and a second major structured surface; a backing layer (which can be called backing 2, the backing introduced in Claim 21), where backing 2 is on the second major structured surface; and an additional adhesive layer (as claimed in Claim 6) which has a non-structured exposed adhesive surface that can be adhered to a target substrate.

In summary, Applicant submits that the rejection of claims 1, 3-8, 10-17, 19-21, 28-35 and 56-60 under 35 USC § 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

§ 102 Rejections

Claims 1, 3, 4, 7, 8, 11-14, 16, 19, and 20 stand rejected under 35 USC § 102(b) as being anticipated by US Patent No. 2,638,430 “Mann”.

Mann teaches a surface covering article in which an adhesive is coated onto a liner. The coated adhesive may have ridges on the surface (figures 2 and 3). A surface covering, such as a tile, is placed onto the ridged adhesive surface, presses down on the ridges and forms continuous channels between the adhesive and the tile surface. The patent office contends that these continuous channels are “discrete reservoirs” as defined in Claim 1. The present application defines discrete on page 8, lines 5-7 as compartmentalizing and minimizing communication between the contents of neighboring reservoirs. The continuous channels of Mann are intended for air egress and therefore are not discrete reservoirs. Mann in column 6 lines 7-9 “the continuous grooves 42 between the ridges 37 permit air to escape from under the edges of the tiles” and column 6 lines 10-15 “when the rim portions 39 of the tiles are in final position abutting the strip 18 adequate space is still provided in the enclosed pockets 42 for slight displacement of or compression of air which may be trapped beneath individual tiles”. Therefore there is no teaching in Mann of the discrete reservoirs between the structured surface of the adhesive layer and the backing.

The rejection of claims 1, 3, 4, 7, 8, 11-14, 16, 19, and 20 under 35 USC § 102(b) as being anticipated by US Patent No. 2,638,430 “Mann” has been overcome and should be withdrawn.

§ 103 Rejections

Claims 5, 10, 22, 26 and 56-60 stand rejected under 35 USC § 103(a) as being unpatentable over US Patent No. 2,638,430 “Mann”.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.

The patent office contends that Mann fails to disclose the peel strength, thickness or volume of the voids/reservoir/channels, but it would have been obvious to one of ordinary skill in the art to have modified the teachings of Mann to achieve the claimed ranges. As stated above Mann fails to teach an article with discrete reservoirs between the structured surface of the adhesive layer and the backing. Therefore Mann cannot be modified to achieve the claimed ranges.

The rejection of claims 5, 10, 22, 26 and 56-60 under 35 USC § 103(a) as being unpatentable over US Patent No. 2,638,430 “Mann” has been overcome and should be withdrawn.

Fees

- Any required fee will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.17 which may be required to Deposit Account No. 13-3723.
- Please charge any fees under 37 CFR §§ 1.16 and 1.17 which may be required to Deposit Account No. 13-3723. (One copy of this sheet marked duplicate is enclosed.)
- Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.
- Please credit any overpayment to the same deposit account.

In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration of the application is requested.

Respectfully submitted,

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